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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/651,693 | 08/29/2003 | Mark A. Shadle | Shadle 08/03 | 9213 |
| 29988 | 7590 | 11/18/2004 | EXAMINER | |
| THOMAS B. RYAN HARTER, SECREST & EMERY LLP 1600 BAUSCH & LOMB PLACE ROCHESTER, NY 14604-2711 | | | HENDERSON, MARK T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3722 | |

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/651,693 | Applicant(s) SHADLE ET AL | |
| | Examiner Mark T Henderson | Art Unit 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 14-19 is/are allowed.
 6) ☒ Claim(s) 1-8, 11-13, 20-33 is/are rejected.
 7) ☒ Claim(s) 9 and 10 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. None of the claims have been amended. However, the applicant is requesting reconsideration of the rejection from the previous office action.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-3, 5-8, and 11-13 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Good et al (5,912,759).

Good et al discloses in Fig. 7 and 8, an irreversible display comprising: an aluminum metal film (130) which can be shaped and sized (thickness) to clear at a particular rate (Col. 7, lines 60-65) ; a display window (128) aligned with the metal film (130); a colored (Col. 2, lines 60-65) ink patch or metal film color contrasting information indicium (132) aligned with the display window and obscured by metal film (130); wherein the window provides access (however, not direct visual access), wherein the window, when tampered, breaks the passivation chemical agent layer (114) which in turn comes in to contact with the metal film (130) that clears a portion of the film; a substrate (134) supporting the metal film (130); wherein the metal film is vapor deposited onto the substrate (Col. 8, lines 25-30), wherein the substrate is transparent (Col. 7,

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lines 47-53, wherein the substrate can be a window); a top substrate (126) and a bottom substrate (134), wherein the top substrate has a window (128); wherein the indicium (132) is supported adjacent to the bottom substrate (134) and is separated from the top substrate by the metal film (130); wherein the window (128) is also the transport layer, wherein an end user applies pressure to force the clear agent (114) to the metal film (130) as stated in Col. 7, lines 29-38; a protective layer (118 and 112) laid out in a pattern on the metal film (130).

3. Claims 20-25, 27, 30-33 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell et al (6,243,192).

Mitchell et al discloses in Fig. 16-18, an irreversible display comprising: an opaque metal film (274) having an adjustable thickness (Col. 3, lines 29-33) which can be either zinc or aluminum (Col 16, lines 25-33) supported by a substrate (278 or 280); a transparent (Col. 13, lines 8-11) protective layer (272) located between the display window (in 278) and laid out in a pattern on the metal film (274); a first portion (shown in Fig. 17, in which the left periphery of the metal film is the first portion) that is not covered by the protective layer (272) being accessible to the clearing agent; a second portion (top surface of the metal film (274) that is covered by the protective layer being temporarily inaccessible to the clearing agent; wherein the first and second portions of the metal film being arranged for producing a viewable pattern (seen in Fig. 18, wherein the graphics layer (284) will be exposed); in which the substrate is one of a top substrate (278) having a window (seen in Fig.16), and a bottom substrate (280) between which a metal film

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(274) is mounted; wherein the display window is formed by an opening through which the clearing agent (276) can be applied to the first portion of the metal film (seen in Fig. 18); wherein the clearing agent (276) is transparent (Col. 13, lines 25-28) and is confined within a reservoir (292, seen in Fig. 16 and 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Mitchell et al.

Good et al discloses an irreversible display comprising all the elements as claimed in Claims 1 and 14, and as set forth above.

However, Good et al does not disclose: wherein the metal film is made out zinc.

Mitchell et al discloses a metal film which can be made out of zinc or copper (Col. 16, lines 25-33).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Good et al's display with a metal film made of zinc as taught by Mitchell et al for providing an alternative metal that reacts with a clearing agent.

5. Claims 28 and 29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al.

Mitchell et al discloses an irreversible display comprising all the elements as claimed in Claim 20, and as set forth above. Mitchell further discloses a spacer (seen in Fig. 17) which spaces the clearing agent from the metal film.

However, Mitchell does not disclose: where the clearing agent overlies the metal film.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the clearing agent at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Applicant has not disclosed that the location of the clearing agent relative to the metal film is critical to his invention, and the invention would work equally as well with the clearing agent any desirable location in which it can access the metal film.

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Allowable Subject Matter

6. Claim 9, 10 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 14-19 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses an irreversible display comprising; a metal film supported between two substrates; a display window formed in one of the substrates; an indicium aligned with the display window; and an opening in one of the substrates providing access to the metal film; and including all of the other limitations in the independent claim.

Response to Arguments

9. Applicant's arguments filed July 26, 2004 have been fully considered but they are not persuasive.

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In response to applicant's argument that the Good et al, and Mitchell et al references were not suitable for the 102(b) rejection given in the last office action, the examiner submits that the claims are now rejected under 102(e) using the same references as stated above.

In response to applicant's argument that the Good et al reference does not disclose a window providing access to the metal film for exposing the metal film to a chemical agent, the examiner submits that the Good et al does provide a window providing access (however, not direct visual access, or direct visual exposure) to a metal film, as stated above in the 102(e) rejection.

In response to applicant's argument that the Mitchell et al does not disclose "a protective to be laid out in a pattern on the metal film and further since "the electrode layer 272 (indicated in the office action as the protective layer)" does "not protect the metal layer", the examiner submits that claim 20 merely discloses a protective layer. The applicant does not further disclose wherein the "protective layer" protects or surrounds any other layer or substrate. Therefore, the examiner has interpreted that the "protective layer" in its broadest sense, merely covers the metal film on its top surface, however leaving the periphery edge of the metal film exposed. The applicant must disclose in further detail what the protective layer is protecting. Furthermore, it is noted that the features upon which applicant relies (i.e., protective layer to protect the metal layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Conclusion

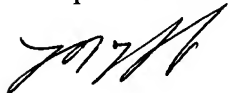
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 12, 2004



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